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FAX COVER SHEET

March 2, 2004

<u>TO</u>:   **Examiner Diane Lee**
             Art Unit 2876
             United States Patent and Trademark Office

             FAX number: (703) 872-9306
             Voice number:

<u>FROM</u>:   **Steven Ormiston**

<u>RE</u>:   **Serial No. 09/965,386**

<u>PAGES</u>:   Number of pages, including this cover sheet: 9

<u>ADDITIONAL MESSAGE</u>:

The following documents are enclosed for filing:
  1. Amendment Transmittal Letter
  2. Response to the Office Action mailed December 2, 2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO.   10017511-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Anderson et al.	Confirmation No.: 2925
Application No.: 09/965,386	Examiner: D. Lee
Filing Date: Sep. 27, 2001	Group Art Unit: 2876

Title: Systems and Methods For Automatic Language Selection for System User Interface

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:
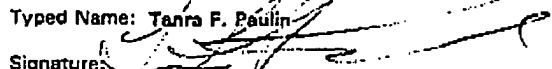
(X) Response/Amendment   ( ) Petition to extend time to respond

( ) New fee as calculated below   ( ) Supplemental Declaration

(X) No additional fee   (Address envelope to "Mail Stop Non-Fee Amendment")

(X) Other: Copy of IDS & return postcard filed 9/24/03 _____ (fee $_____)

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	25	MINUS	21	= 4	X $18	$ 72
INDEP. CLAIMS	6	MINUS	6	= 0	X $86	$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ $290	$ 0

EXTENSION FEE	1ST MONTH $110.00	2ND MONTH $420.00	3RD MONTH $950.00	4TH MONTH $1480.00	$ 0
				OTHER FEES	$
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	$ 72

Charge $ 72   to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (703) 872-9306 on Mar. 2, 2004.
Number of pages: 9

Typed Name: Tanra F. Paulin

Signature: _____

Anderson et al.

By _____

Steven R. Ormiston

Attorney/Agent for Applicant(s)

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
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(X)   Response/Amendment   ( )   Petition to extend time to respond
( )   New fee as calculated below   ( )   Supplemental Declaration
(X)   No additional fee   (Address envelope to "Mail Stop Non-Fee Amendment")
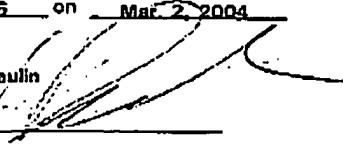(X)   Other: _Copy of IDS & return postcard filed 9/24/03_____ (fee $_____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	25	MINUS	21	= 4	X $18	$ 72
INDEP. CLAIMS	6	MINUS	6	= 0	X $86	$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ $290	$ 0
EXTENSION FEE	1ST MONTH $110.00	2ND MONTH $420.00	3RD MONTH $850.00	4TH MONTH $1480.00		$ 0
					OTHER FEES	$
					TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	$ 72

Charge $___72___ to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(X) I hereby certify that this paper is being transmitted
to the Patent and Trademark Office facsimile
number _(703) 872-9306_____ on __Mar. 2, 2004__
Number of pages: 9

Typed Name: Tanra F. Paulin

Signature:

Anderson et al,

By

Steven R. Ormiston

Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being facsimile transmitted to
the U.S. Patent and Trademark Office, facsimile number (703) 872-9306, on the
date shown below.
Date of Facsimile: ⟋ March 2, 2004
Typed or printed name: ⟋Tanra F. Pakffin
Signature:

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MAR 0 2 2004

ATTORNEY
DOCKET NO. 10017511-1

OFFICIAL

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Anderson et al.

SERIAL NO.: 09/965,386   GROUP ART UNIT: 2876

FILED: September 27, 2001   EXAMINER: D. Lee

TITLE: Systems and Methods for Automatic Language Selection
         for System User Interface

REMARKS RESPONDING TO THE OFFICE ACTION
MAILED DECEMBER 2, 2003

Applicants request that the Examiner reconsider the rejection of all pending
claims, Claims 1-4, 6-9, 11-15, 17-23 and 25. For the reasons detailed below,
Applicants submit, respectfully, that the Examiner's two-layered obviousness analysis is
not sufficient to support the rejections.

In stretching to make the prior art reach the claimed invention, the Examiner
makes an unusual two-layered obviousness analysis. First, she asserts the
combination of Matsukawa (5,436,436) and Abe (5,895,903) is obvious. Then, second,
she asserts that it is obvious to modify the combination to meet all of the claim

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limitations. Even assuming the combination of Matsukawa and Abe is properly motivated, the modification of the combination is not.

Claims 1, 7, 12 and 20 recite, in various forms, the use of a portable memory that includes two language identifiers such that, if the language associated with the first identifier is not available, the language associated with the second identifier is used. The Examiner acknowledges that the combination of Matsukawa and Abe does not teach a portable memory with two language identifiers or the use of those identifiers, as claimed. To reach the claimed invention, the Examiner makes the following statement.

> "Matsukawa as modified by Abe does not teach the language of the
> language identifier explicitly having a primary and a secondary identifiers,
> it would have been an obvious to an artisan of ordinary skill in the art at
> the time the invention was made to simplify the user's appropriate
> language selection in the identification data to explicitly identifying the first
> and the second preferred language (i.e., user's most comfortable
> language as the first preferred language and a default language as the
> second preferred language) so that the terminal can most identifies and
> accommodates the user's comfortable language with less operating time
> when the user's first preferred language is not identified or not a popularly
> utilized language by the terminal. Such modification would reduce the
> operating time in determining the specific selection when system finds
> multiple languages that terminal can support from the user's selection."

Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must rely on *objective evidence* and make *specific factual findings* with respect to the motivation to modify references. MPEP § 2143.01.

The Examiner has not made any *specific factual findings* that anything in Matsukawa or Abe suggests or motivates two language identifiers or the use of those identifiers, as claimed. The Examiner also has not made any *specific factual findings* relying on *objective evidence* of anything in the knowledge generally available to those skilled in the art that suggests or motivates the modification to arrive at the two language identifiers and the use of those language identifiers, as claimed. Absent such

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a showing, the Examiner has failed to meet her burden of establishing a prima facie case of obviousness.

Rather than making specific factual findings based on objective evidence, the Examiner speculates on some of the advantages of the claimed invention as the motivation to modify the combination of Matsukawa and Abe. For example, the Examiner asserts that using two language identifiers would "reduce the operating time in determining the specific selection when system finds [sic] multiple languages that terminal can support...." This is pure speculation. The Examiner has no way of knowing if this is true. Certainly, she has not cited to anything in the prior art or in the knowledge generally available to a person skilled in the art that would support her speculation.

Even assuming the Examiner's statement is correct, it is only through impermissible hindsight after reading the Applicants specification that any such advantage becomes apparent. There is simply nothing in the cited art that would cause a person skilled in the art to pause and think, "gosh, if I store two language identifiers on a portable memory then I can reduce the operating time of the display device."

The Examiner is urged to look closely at MPEP § 2143.01 before issuing an advisory action maintaining the obviousness rejection of the claims. It is clear that the Examiner may not speculate on the advantages of the claimed invention and then use any such advantage as the motivation to modify a reference or combination of references. The rejections should be withdrawn unless and until the Examiner provides *objective evidence* and makes *specific factual findings* with respect to the motivation to modify the combination of references.

Considering the Previously Filed IDS.

The Examiner is requested to consider the references cited on the Information Disclosure Statement filed September 24, 2003, if she has not already done so, and return an initialed copy of the IDS with the notice of allowance or other reply to this Response. (A copy of the IDS accompanies this Response.)

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PAGE 6/9 * RCVD AT 3/2/2004 12:51:16 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:208 433 9295 * DURATION (mm-ss):02-16

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

E. Anderson et al.

By

Steven R. Ormiston
Reg. No. 35,974
208.433.1991 x204

March 2, 2004

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